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| 27045 | 7590 | 05/13/2010 | | |
| ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024 | | | EXAMINER THOMPSON, MICHAEL M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3629 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

kara.coffman@ericsson.com
jennifer.hardin@ericsson.com
melissa.rhea@ericsson.com

Office Action Summary

Application No.

10/500,770

Applicant(s)

LEWIS, PETER REGINALD

Examiner

Michael M. Thompson

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Kalmanek, Jr. et al. (US 6,483,912) (hereinafter “Kalmanek”)**
3. **With respect to claim 23**, Kalmanek teaches a method for managing credit of an account in a multi-service telecommunications system that comprises a credit management system (i.e. via at least the gate controllers shown at col. 6-7, for the proposition that the gate controllers are a part of a system that manages “units” or service) and service capability servers providing services in exchange for units (i.e. via at least the server support of the gate controllers as discussed at col. 8, lines 1-19, *passim*, for the proposition that the gate controllers require server support that provide services based on subscription as in pre-paid scenarios) for managing unit reservation of an account by a credit management system associated with the service telecommunications system (i.e. management of accounts including prepaid scenarios are shown at col. 5, lines 7-26; col. 8, lines 57-64; col. 9, lines 57-67; accounting

information at col. 49, lines 27-36) and the services are provided in exchange for the method comprising: reserving a predetermined amount of units for the account before provisioning of a service (i.e. via at least the pre-paid method of the current system at col. 9, lines 57-67), **and if** a service capability server reservation of credits for a next service request to be provided cannot be granted due to an insufficient amount of reserved units for the account; instead of denying the reservation, the credit management system sending a message for forced booking of consumed units to all service capability servers connected with the account; and the credit management system releasing any remaining reservations of units to ensure a total balance in the account is up to date at the moment the forced booking takes place. At the outset, it is the Examiner's position that "[l]anguage that suggests or makes optional *but does not require steps to be performed* or does not limit a claim to a particular structure *does not limit the scope of a claim or claim limitation*." MPEP 2106 II C. Applicant introduced the conditional statement on amendment in order to clarify rejections under 35 U.S.C. 112, thereby providing conditional language within the method. Therefore the limitations beyond the conditional statement do not limit the scope of the claims. As the language suggests two possible paths, when there is a sufficient amount of reserved units available, the reservation is made.

4. **With respect to claim 24**, Kalmanek teaches the method according to claim 23, wherein said forced booking is carried out if said amount of units drops below a predetermined threshold. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not

limit the scope of a claim or claim limitation. MPEP 2106 II C; In re Johnston, 77 USPQ2d 1788 (CAFC 2006) ("As a matter of linguistic precision, optional claim elements do not narrow claim, since they can always be omitted;" In this case the term "if" is in the permissive form.)

5. **With respect to claim 25**, Kalmanek teaches the method according to claim 24, wherein said forced booking is service dependent. (i.e. in this case the booking is service dependent on prepaid accounts associated with the cost of a call. Similarly, other services such as call-waiting, three-way, etc. are described, passim)
6. **With respect to claim 26**, Kalmanek teaches the method according to claim 25, wherein in connection with said forced booking a request for accreditation of units can be carried out for said services. (i.e. remaining time is inherently accounted for, when allocating additional services in a pre-paid model under the rereserve, recommit, etc., methods.)

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 27-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalmanek ('912) in view of Smith et al. (WO 98/56160) (hereinafter "Smith").**

9. **With respect to claim 27**, Kalmanek teaches the method according to claim 26, except for explicitly reciting wherein the accreditation of said units is subject to a plurality of accreditation rules. While the Examiner believes that accreditation occurs when linking to the account and/or a pre-paid account in Kalmanek, it is believed that Smith. provides greater teachings with respect to pre-paid accounts. Smith teaches that time is "accredited" by different methods as described on pages 8-9 lines 27-9 and as well on pages 10-13 in the form of rules for accreditation. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of invention to have modified or added (if not already inherent in the process) the ability to accredit units with the use of accreditation rules for the well known purpose of properly allocation or provisioning services as is well known in the art.

10. **With respect to claim 28**, Kalmanek and Smith in combination teach the method according to claim 27, wherein Smith further teaches that at least one of said accreditation rules is dependent on the actual use of said units per unit of time per service. (i.e. all calculations are related to actual use and are based on time when using the prepaid calling service since determining the calling time that remains is critical. These methods are exemplified by the different methods as described on pages 8-9 lines 27-9 and as well on pages 10-13 of Smith.

11. **With respect to claim 29**, Kalmanek and Smith in combination teach the method according to claim 27, wherein Smith further teaches that at least one of said accreditation rules is dependent on a classification of said services. (i.e. such as the

accreditation rules of 27, they are related to the phone billing services, pages 8-9 lines 27-9 and as well on pages 10-13.)

12. **With respect to claim 30**, Kalmanek and Smith in combination teach the method according to claim 29, wherein Smith further teaches that classification is a prioritization. (i.e. in this case the priority is related to prepaid calling services. On page 7 lines 2-4 other types of services are indicated.)

13. **With respect to claim 31**, Kalmanek and Smith in combination teach the method according to claim 27, wherein Smith further teaches that at least one of said accreditation rules is dependent on the amount of units requested. (i.e. accreditation rules inherently rely on the amount of units requested to determine the amount of units remaining as described on, for example, pages 8-9 lines 27-9 and as well on pages 10-13 in the form of rules for accreditation.)

14. **With respect to claim 32**, Kalmanek and Smith in combination teach the method according to claim 27, wherein Smith further teaches that at least one of said accreditation rules is dependent on the life-span of requested units. (i.e. rules such as the initial "typical duration" of 4 minutes withdrawn amount on page 5 lines 11-27 relating to a "life-span" of requested units.)

15. **With respect to claim 33**, Kalmanek and Smith in combination teach the method according to claim 32, wherein Smith further teaches that said units are monetary units. (i.e. inherently the units are related to both time and money where units of time are used as a quantity at a given rate translating to monetary value. The terms are synonymous especially in the context of prepaid calling services where calling times are typically

related in total minutes at a given value thereby conferring a monetary unit.)

Regardless, the specific type of "units" is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The steps previously recited would be performed the same regardless of what type of units they are. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

16. **With respect to claim 34**, Kalmanek and Smith in combination teach the method according to claim 32, wherein Smith further teaches that said units are units of time. (i.e. Similarly, the units are inherently related to both time and money where units of time us used as a quantity at a given rate translating to monetary value. The terms are synonymous especially in the context of prepaid calling services where calling times are typically related in total minutes at a given value thereby conferring a monetary unit.) Regardless, the specific type of "units" is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The steps previously recited would be performed the same regardless of what type of units they are. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

17. **With respect to claim 35**, Kalmanek and Smith in combination teach the method according to claim 32, wherein Smith further teaches that said units are units of volume. (i.e. the units are inherently a unit of volume, since the total time allocated at a given

prepaid price will constitute a volume of time. Similarly not the rationale in the rejection of claims 26 and 27.) Regardless, the specific type of "units" is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The steps previously recited would be performed the same regardless of what type of units they are. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

18. **With respect to claim 36**, Kalmanek and Smith in combination teach the method according to claim 35, wherein Smith further teaches that said volume is a data volume. (i.e. may be interpreted as call data or service data collected by the Service Data Function, on page 6-7, lines 12-23, and/or any type of call as described on page 8, lines 7-11.) Regardless, the specific type of "units" is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The steps previously recited would be performed the same regardless of what type of units they are. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

19. **With respect to claim 37**, Kalmanek and Smith in combination teach the method according to claim 32, wherein Smith further teaches that said units relate to the amount of used bandwidth. (i.e. the use of certain different types of call including voice and/or videoconferencing telephone calls, facsimile calls, and calls to transfer data as

described on page 8 lines 7-11, create bandwidth related to the exchange of information over communication lines. Such as often the case in dial up services. Also note that page 7, lines 24-31 refer to other interfaces and networks such as a radio air interface as well as other mobile models.) Regardless, the specific type of "units" is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The steps previously recited would be performed the same regardless of what type of units they are. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

20. **With respect to claim 38**, Kalmanek and Smith in combination teach the method according to claim 37, wherein Smith further teaches that said account can be accessed by at least one user. (i.e. the use of the term "subscriber's account" designates the use of an accessible account providing for a method of determining, in the least, the time remaining on the account. Similarly, the claim may be interpreted to mean that at least one user can access the prepaid account, such as when they make a call on the account they have accessed the account for prepaid services.) Further, language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. MPEP 2106 II C; *In re Johnston*, 77 USPQ2d 1788 (CAFC 2006)

21. **With respect to claim 39**, Kalmanek and Smith in combination teach the method according to claim 38, wherein Smith further teaches use in a telecommunications

environment, wherein at least one of the services provided relates to a group comprising voice, data and internet communications. (i.e. the use of certain different types of call including voice and/or videoconferencing telephone calls, facsimile calls, and calls to transfer data as described on page 8 lines 7-11, create bandwidth related to the exchange of information over communication lines.)

22. **With respect to claim 40**, Kalmanek and Smith in combination teach the method as described in claim 39, wherein Smith further teaches that said telecommunications environment is accessible via a group comprising wireless and fixed connections to a telecommunications network. (i.e. Please note that page 7, lines 24-31 and page 8, lines 1-6 refer to other interfaces and networks such as a radio air interface as well as other mobile models. Also note that pages 12-13, lines 20-5 refer to fixed networks.) Please note that Kalmanek may be used similarly.

23. **With respect to claim 41**, Kalmanek and Smith in combination teach the method according to claim 40, wherein Smith further teaches that management or provisioning of said services is carried out by a plurality of service provisioning systems which are in communicative connection with said credit management. (i.e. service provisioning systems such as the Service Data Function, Service Control Function, Intelligent Network, Service Control Points, Service Switching Function or Mobile Station Integrated Services Digital Network Number are some examples. These are found throughout and related to the credit management or determination of allocations.) Please note that Kalmanek uses a plurality of services.

Response to Arguments

24. Applicant's arguments with respect to claims 23-41 have been considered but are moot in view of the new ground(s) of rejection. It should be noted that the optional language of claim 23 serves to make optional additional dependent claims. The Examiner has made an effort to maintain similar rejections with respect to the claims, specifically those claims directed to accreditation (i.e. claims 27 and 32) in order to advance prosecution.

Conclusion

25. The Examiner has pointed out particular references contained in the prior art of record, within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Thompson whose telephone number is (571) 270-3605. The examiner can normally be reached on Monday thru Friday 8am-5:30 except Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M Thompson/
Examiner, Art Unit 3629

/JOHN G. WEISS/
Supervisory Patent Examiner, Art Unit 3629